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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/789,750 | 02/27/2004 | Volker Wendel | 104035.274126 | 9604 |
| 826 | 7590 | 06/22/2006 | EXAMINER | |
| ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000 | | | DODSON, SHELLEY A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1616 | |

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/789,750 | Applicant(s) WENDEL ET AL. | |
| | Examiner SHELLEY A. DODSON | Art Unit 1616 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SHELLEY A. DODSON
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/2005; 2/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-30 are pending in this application filed 02/27/2004.

Applicant's claims are directed toward stabilization of UV-sensitive active ingredients.

DOUBLE PATENTING

1.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225

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USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.

Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/500,869; over claims 1-28 of copending Application No. 10/789,753; over claims 1-24 of copending Application No. 10/789,751; over claims 1-41 of copending Application No. 10/789,881; over claims 1-24 of copending Application No. 10/789,641 and over claims 1-34 of copending Application No. 10/788,607. Although the conflicting claims are not identical,

they are not patentably distinct from each other because both the instant application and all of the above stated copending applications are claiming a cosmetic or dermatological formulation comprising at least one UV filter substance and at least one dialkyl naphthalate of the exact same structural formula.

3.

Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/789,711 in view of USP 6,660,402 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application as well as the instant application are claiming a cosmetic or dermatological formulation comprising at least one UV filter substance and at least one dialkyl naphthalate of the exact same structural formula. The copending application differ from the instant claims because of the presence of one insect repellent compound, more specifically DEET.

Gonzalez et al. disclose photostable sunscreen compositions comprising a sunscreen active and a cosmetically acceptable vehicle. In column 4, lines 50-65, Gonzalez further discloses that one or more insect repellents may also be present such as DEET. It

would have been obvious to one of ordinary skill in this art at the time the invention was made to have included the DEET of Gonzalez into the instant composition in view of the teaching of Gonzalez that insect repellents are present in sunscreens compositions. This is in the absence of any clear showing of unexpected results attributable to the presence of DEET in the referenced claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

7.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as the referenced application at the time this invention was made. Accordingly, the reference is disqualified as

prior art through 35 U.S.C. § 102(f) or (g) in any rejection under 35 U.S.C. § 103 in this application. However, this reference additionally qualifies as prior art under section of 35 U.S.C. § 102 and accordingly is not disqualified as prior art under 35 U.S.C. § 103.

8.

Applicant may overcome the referenced application either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another", or by antedating the referenced application under 37 CFR 1.131.

DOUBLE PATENTING

9.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10.

Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,368,578 B1; over claims 1-9 of U.S. Patent No. 6,355,230 B2 and over claims 1-4 of U.S. Patent No. 6,491,901 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and all three of the above stated Gers-Barlag et al. patents are claiming a cosmetic or dermatological formulation comprising at least one UV filter substance and at least one dialkyl naphthalate of the exact same structural formula. No patentable distinction can be found between the instant claims and the above stated referenced patents.

11.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

13.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

14.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as the reference at the time this invention was made. Accordingly, the reference is disqualified as prior art through 35 U.S.C. § 102(f) or (g) in any rejection under 35 U.S.C. § 103 in this application. However, this reference additionally qualifies as prior art under section of 35 U.S.C. § 102 and accordingly is not disqualified as prior art under 35 U.S.C. § 103.

Applicant may overcome the reference either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another", or by antedating the reference under 37 CFR 1.131.

Claim Rejections - 35 USC § 102

15.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

16.

Claims 1-9 and 20-30 are rejected under 35 U.S.C. 102(e) as being anticipated by all Gers-Barlag et al patents USP 6,368,578 B1(R1), USP 6,355,230 B2(R2) and USP 6,491,901 B2(R3).

All Gers-Barlag et al patents disclose stabilization or oxidation and/or UV-sensitive active ingredients. Gers-Barlag discloses a cosmetic or dermatological formulation comprising at least one UV active ingredient and at least one dialky naphthalate of the same structural formula claimed by the applicant in the instant case. In column 12 and 13, R1 discloses the specific hydrophilic active ingredients more specifically, alpha glucosylrutin. In columns 12 and 13 other active ingredients such as vitamin A, E, carotene, retinoids, creatine etc are disclosed in the same amounts and proportions claimed by the applicant. In column 14, the reference discloses that the composition is an oil-in-water emulsion. Columns 15-17 disclose all of the specific UV screening agents claimed by the applicant in the instant invention. Gers-Barlag(R1) discloses each and every aspect of the invention as claimed by the applicant in the instant invention. In columns 5 and 6, R2 discloses the specific hydrophilic active ingredients such as alpha glucosylrutin. Additionally in the same columns vitamins A, E, carotene, retinoids, creatine etc are also disclosed in the same amounts and proportions. In column 7, R2 discloses that the composition is an oil-in-water emulsion. R2 discloses all claimed UV actives in columns 8 through 20, in the same amounts and

proportions. In columns 6, R3 discloses that the composition is an O/W emulsion. The specific active UV ingredients are found in columns 4-11 in the same amounts and proportions. Columns 11 and 12 disclose other active ingredients such as vitamins A, E, creatine, retinoids, carotene and alpha glucosylrutin. All three Gers-Barlag patents disclose each and every aspect of the invention as claimed by the applicant in the instant invention.

Claim Rejections - 35 USC § 103

17.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18.

Claims 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over all Gers-Barlag et al patents USP 6,368,578 B1(R1), USP 6,355,230 B2(R2) and USP 6,491,901 B2(R3) in view of Lukenback et al USP 5,980,871(R4).

All Gers-Barlag et al patents disclose stabilization or oxidation and/or UV-sensitive active ingredients. Gers-Barlag discloses a cosmetic or dermatological formulation comprising at least one UV active ingredient and at least one dialky naphthalate of the same structural formula claimed by the applicant in the instant case. In column 12 and 13, R1 discloses the specific hydrophilic active ingredients more specifically, alpha glucosylrutin. In columns 12 and 13 other active ingredients such as vitamin A, E, carotene, retinoids, creatine etc are disclosed in the same amounts and proportions claimed by the applicant. In column 14, the reference discloses that the composition is an oil-in-water emulsion. Columns 15-17 disclose all of the specific UV screening agents claimed by the applicant in the instant invention. Gers-Barlag(R1) discloses each and every aspect of the invention as claimed by the applicant in the instant invention. In columns 5 and 6, R2 discloses the specific hydrophilic active ingredients

such as alpha glucosylrutin. Additionally in the same columns vitamins A, E, carotene, retinoids, creatine etc are also disclosed in the same amounts and proportions. In column 7, R2 discloses that the composition is an oil-in-water emulsion. R2 discloses all claimed UV actives in columns 8 through 20, in the same amounts and proportions. In columns 6, R3 discloses that the composition is an O/W emulsion. The specific active UV ingredients are found in columns 4-11 in the same amounts and proportions. Columns 11 and 12 disclose other active ingredients such as vitamins A, E, creatine, retinoids, carotene and alpha glucosylrutin. All three Gers-Barlag patents disclose each and every aspect of the invention as claimed by the applicant in the instant invention with the exception of the presence of phosphate and sulfate emulsifiers.

Lukenbach et al. disclose sunscreen compositions containing inorganic and organic sunscreen agents. In column 5, lines 15-35, R4 discloses that emulsifiers are also present, more specifically, cetyl phosphate as well as sodium sulfate in the same amounts and proportions claimed by the applicant in the instant case. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified all of the Gers-Barlag patents with the emulsifiers of Lukenbach in view of the teaching

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of Lukenbach that emulsifiers claimed by the applicant in the instant case are a known active ingredient in sunscreen compositions. This is in the absence of any clear showing of unexpected results attributable to the presence of the specific emulsifiers claimed by applicant.

Information Disclosure Statement

19.

The information disclosure statements (IDS) submitted were noted and the submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements and made them of record.

Telephone Inquiries

20.

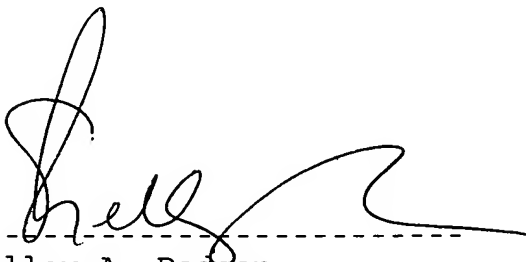
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley A. Dodson whose telephone number is (571) 272-0612 and fax number (571) 273-0612. The examiner can normally be reached on Monday-Thursday from 7:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached at (571) 272-0646.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence numbers to Group 1600. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more

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information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shelley A. Dodson
Primary Examiner
Art Unit 1616

June 19, 2006